

Remarks:

In the Final Office Action mailed on November 5, 2004, the Examiner rejected claims Claims 37, 41, 42, and 44-53 under 35 USC 103(a). Claims 32-36 were allowed. Applicants amend claims 37, 42, 46, 47, and 48 herein. Claims 32-37, 41, 42, and 44-53 are pending in the application.

35 USC 103(a)

a. Claims 37, 46-53 stand rejected under 35 USC 103(a) as unpatentable over Shinagawa (Japanese Patent Number: JP401280889A, hereinafter “Shinagawa”), Kawan (U.S. Patent Number 7,796,832, hereinafter “Kawan”), and further in view of Kusakabe (U.S. Patent Number 6,662,286, hereinafter “Kusakabe”).

b. Claim 41 stands rejected under 35 USC 103(a) as unpatentable over Shinagawa, Kawan, Kusakabe, and further in view of Gopal (U.S. Patent Number 5,889,963, hereinafter “Gopal”).

c. Claim 42 stands rejected under 35 USC 103(a) as unpatentable over Shinagawa in view of Kusakabe.

d. Claims 44 and 45 stand rejected under 35 USC 103(a) as unpatentable over Shinagawa, Kusakabe, in view of Gopal.

Of these, Claims 37, 42, 46, 47, and 48 are amended. To the extent that the Examiner may view these rejections as applicable to the claims presented herein, Applicants respectfully traverse.

1. Argument

35 USC 103(a)

Claims 37, 46-53

Claims 37, 46-53 stand rejected under 35 USC 103(a) as unpatentable over Shinagawa , Kawan and further in view of Kusakabe. The proposed combination fails to meet the requirements of a *prima facie* case of obviousness. Accordingly, the rejection should be withdrawn and the claims allowed.

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." MPEP 2143. The Examiner has failed to meet this burden.

Considering the last of these criteria (references when combined must teach or suggest all the claim limitations), it shall be seen that the proposed combinations of Shinagawa, Kawan and Kusakabe fails that criteria.

Claim 37 recites "A smart card comprising:

means configured to simulate the initiation of communications
to a smart card terminal having:

means operable to receive a polling packet from the
terminal; and

means, in response to receiving a polling packet, operable to transmit an indication that the smart card desires to transmit data to the terminal;

means operable to use the means configured to simulate the initiation of communications to request resources selected from the set including terminal resources, host resources, and network resources.”

The Examiner has relied upon Shinagawa for the teaching of “communicate in an asynchronous manner” (which has now been redrafted to clarify the scope of the invention), Kawan for the teaching of the element of “to request ... network resources”, and Kusakabe for the teaching of the element of “receiving a polling packet”.

Consider the first element of Claim 37: “means configured to simulate the initiation of communications to a smart card terminal.” Shinagawa does not teach or suggest this element. Shinagawa, in fact, teaches away from this element of the claimed invention. Shinagawa describes a system in which either the smart card or the terminal can be master. Only in response to a command string can the slave communicate a mode change to become master. However, there is no mechanism taught by which the current slave can initiate a communication.

Shinagawa shows in Figure 2 “a diagram for illustrating the format of the transmitting data” (Shinagawa, page 12, paragraph 6). “[T]ransmitted data 14 either in command string 3 or in response string 4 becomes the master, and the other becomes the slave each time they are transmitted according to the system indicated by mode identification 13” (Shinagawa, page 7, paragraph 2). *Mode* in Shinagawa refers to whether the unit (card or host) is operating as *slave* or *master*. Thus, it appears that in Shinagawa the slave transmits only in response to a command string and it is in this response that it can communicate a mode change, which would be consistent with the accepted notion of master-slave systems. Being a master-slave system, it is not surprising that Shinagawa fails to teach or suggest “means configured to simulate the initiation of communications to a smart card” (claim 37).

As the Examiner has acknowledged “Shinagawa does not teach means operable to receive a polling packet from the terminal and in response to receiving a polling packet, operable to transmit an indication that smart card desires to transmit data to the terminal” (Office Action, Page 3, lines 13-16). The Examiner has erroneously asserted that Kusakabe provides this teaching. As Applicants pointed out in the response filed on 15 July 2004:

It should go without saying that in an obviousness analysis one must consider the entire claim and therefore each claim element in its entirety. The word “polling” only occurs once in the entire Kusakabe reference. In that sentence (Col. 12, lines 4-6) Kusakabe states “when the R/W1 performs, polling, the IC card 2 sends back version numbers of these two keys (the common key and the provider key). Sending back version numbers cannot be deemed a teaching of “operable to transmit an indication that smart card desires to transmit data to the terminal””? (Response of 15 July 2004)

Kusakabe does not teach or suggest polling in the general sense of the word. As defined in Newton’s Telecom Dictionary (cited by the Examiner) *polling* means establishing a connection to another node to determine if that node has information to send. In other words, *polling* is a mechanism by which one node can determine whether the other node desires to send something. In the Newton Telecom Dictionary the example provided is for one computer asking remote locations if they desire to transmit something. Kusakabe’s use of the word *polling* is inconsistent with this definition. Kusakabe teaches a system in which:

“FIG 1. shows one example of a noncontact card system utilizing a reader/writer R/W 1 and IC card 2. ...

When the R/W 1 transmits a predetermined command to the IC card 2, the IC card 2 is set to receive that command and perform processing corresponding to that command.” (Kusakabe, Col. 7, lines 3-9).

There is no hint in Kusakabe of the IC card ever desiring to initiate a transmission. On the contrary, the Kusakabe system is directed to transmitting specific

data in response to queries from the reader/writer (e.g., “An information processing apparatus according to another embodiment is characterized by comprising a receiving means for receiving a command from a predetermined user, a processing means for processing the command, a transmitting means for transmitting results of the processing, and a memory means including a first area for storing data or one user or more and second area used by one user or more stored in the first area and managed in a physical block unit having a predetermined size ...” (Kusakabe, Col. 2, lines 51-59).

The Examiner asserted that “Kusakabe teaches a smart card terminal that performs polling (see column 12, lines 4-8), i.e., sends a control message to a an (sic) IC card to see if it has any information to send” (Office Action, Page 12, lines 6-9. That is an incorrect reading of Kusakabe. Col. 12, lines 4-8 states that “when the R/W 1 (i.e., the terminal) performs polling, the IC card 2 sends back version numbers of these two keys (the common key and the provider key).” That is the only use of the word *polling*. Applicants posit that that use of *polling* is inconsistent with the definition in Newton’s Telecom Dictionary. It appears that the terminal requests that the IC card returns some specific information in response to a query. That is not equivalent to a network where “a central computer ... asks each remote location whether they *want* to send some information” (Newton’s Telecom Dictionary).

However, even if, solely for the sake of argument, one would agree that Kusakabe did teach that the terminal polls the smart card, it still does not meet the second part of applicants’ claim element that the IC card responds with an “an indication that the smart card desires to transmit data to the terminal” (Claim 37). Rather, in Kusakabe the IC card responds with two keys used for a security purpose. That is not a teaching or a suggestion of the claimed element.

Furthermore, Claim 37 recites that the smart card “[uses] the means configured to simulate the initiation of communications to request resources from the set including terminal resources, host resources, and network resources.” The Examiner has acknowledged that Shinagawa “fails to explicitly set forth the limitation of network resources” (Office Action, paragraph bridging pages 2 and 3). The Examiner looked to

Kawan for that teaching. Kawan does not teach or suggest “to request resources selected from the set ... network resources” (Claim 37).

Kawan teaches no more than a system in which smart cards are used in a network by being connected to the network via readers and intermediary computers (Kawan, Figure 4). Kawan teaches that “the terminal 100 may be advantageously used to read data stored on a smart card to determine, for example, a value corresponding to an amount of funds existing in the user’s account”, and “the card first encrypts, then transmits to the terminal 100 information stored on a (sic) smart card”. Furthermore, “the smart card in the system preferably acts as an enabling device for other systems according to known techniques. For example, the smart card provides validation of the individual and the service requested.” Kawan, Col. 8, lines 8-12. These types of uses are all reactive and cannot be deemed to teach or suggest “to request” anything, much less “to request ... network resources.”

To meet the third criteria of a *prima facie* case of obviousness the combination must teach or suggest all the claim limitations. Conversely, if the combination fails to teach or suggest one element of a claim, then it has failed as a *prima facie* case of obviousness. As noted above, the proffered combination of Shinagawa, Kawan and Kusakabe does not only fail to teach or suggest one limitation of Claim 37, but fails to teach or suggest every element of Claim 37. Accordingly, Claim 37 cannot be deemed obvious over Shinagawa, Kawan and Kusakabe, taken singly or in combination, and should be allowed.

Claims 41, 46-53

Claims 41, and 46-53 depend from Claim 37, incorporate all the limitations thereof, provide further unique combinations, and are patentable over Shinagawa, Kawan and Kusakabe for the reasons given in support of Claim 37 and by virtue of such further combinations. Claim 41 stands rejected under 35 USC 103(a) as unpatentable over Shinagawa, Kawan, Kusakabe, in view of Gopal. However, Gopal fails to teach or suggest the limitations lacking from the former combination. Accordingly, Claim 37 is

patentable over Shinagawa, Kawan, Kusakabe, and Gopal, taken singly or in any combination. Therefore, Claim 41 is also patentable over that combination for the same reason.

Claims 42, 44, 45

Claim 42 recites “the terminal having a means for simulating allowing the smart card to initiate communication with the smart card terminal by transmitting a polling packet to the smart card requesting an indication of whether the smart card desires to transmit data to the terminal.” As noted above in support of Claim 37 (that argument incorporated here), Shinagawa and Kusakabe fail to teach or suggest such a limitation. Claims 44 and 45 was rejected under the combination of Shinagawa, Kusakabe and Gopal. As noted above, Gopal fails to teach or suggest the limitations lacking from Shinagawa and Kusakabe. Accordingly, Claim 42 is patentable over the combination Shinagawa, Kusakabe, and Gopal. Therefore, Claims 44 and 45 are patentable over these references, taken singly or in combination, for the same reason given in support of Claim 42.

For these reasons, a *prima facie* case of obviousness cannot be established using the Shinagawa, Kawan, Kusakabe, and Gopal references. “If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent.” In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992), *quoted in* In re Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Thus, for the reasons given above, Applicants respectfully request withdrawal of the rejection of the claims and their early allowance.

CONCLUSION

It is submitted that all of the claims now in the application are allowable. Applicants respectfully request consideration of the application and claims and its early allowance. If the Examiner believes that the

prosecution of the application would be facilitated by a telephonic interview, Applicants invite the Examiner to contact the undersigned at the number given below.

Applicants respectfully request that a timely Notice of Allowance be issued in this application.

Respectfully Submitted,



Pehr Jansson
Reg. No. 35,759

Date: July 7, 2005

Pehr Jansson
7628 Parkview Circle
Austin, TX 78731

512-241-0837
678-868-0101 (fax)
pehr@pehrjansson.com

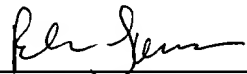
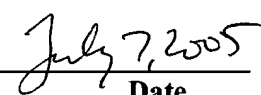
PEHR JANSSON'S LAW FIRM



7628 Parkview Circle, Austin, TX 78731

512 241 0837 · 678 868 0101 (fax) · pehr@pehrjansson.com

COVER SHEET

TO: US Patent and Trademark Office FAX: 703 872-9306 Attn: Commissioner for Patents MAIL STOP: Appeals--Patent From: Pehr Jansson Reg. No. 35,759	CERTIFICATE OF MAILING OR TRANSMISSION UNDER 37 CFR 1.8 I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop RCE, Commissioner for Patents, P.O.Box 1450, Alexandria, VA 22313-1450 or facsimile transmitted to the United States Patent and Trademark Office at fax no. 703/872-9306 addressed to Mail Stop RCE, Commissioner for Patents, on the date indicated above.   Pehr Jansson, Reg. No. 35,759Date
<u>In regard to:</u> Appl. No. : 09/727,174 Conf. No. : 5606 Applicant : Montgomery Filing Date : 30 Nov 2000 Art Unit : 2182 Examiner : Niketa I. Patel Docket No. : 40.0023 C1 Customer No. : 41754	This certificate applies to the following documents transmitted herewith: <ul style="list-style-type: none">• Certificate of Transmission/Cover Sheet (1 page)• Request for Continued Exam. SB-30 & Copy (2 pages)• Petition for Extension of Time & Copy (2 pages)• Credit Card Form 2038 (1 page)• Amendment, Response and Submission under 37 CFR 1.114 (13 pages)

NOTICE OF CONFIDENTIALITY

The accompanying information is: (1) Subject to Attorney-Client Privilege, (2) Attorney Work Product, or (3) Confidential. It is intended for use of the individual or entity named above. If the reader of this message is not the intended recipient, or the employee or agent responsible to deliver it to the intended recipient, you are hereby notified that any dissemination, distribution or copying of this communication is strictly prohibited. If you have received this communication in error, please immediately notify us by telephone, and return the original message to us at the above address. Thank you.

If you do not receive all pages, call 512 241 0837 or e-mail pehr@pehrjansson.com